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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,140	07/10/2003	Albert K. Chin	23488-07931	4442
758	7590	12/10/2007		
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER LANG, AMY T	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 12/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,140

Applicant(s)

CHIN, ALBERT K.

Examiner

Amy T. Lang

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/24/2007, 3/16/2007, 11/13/2006, 5/31/2006, 1/20/2006, 12/02/2005, 11/01/2005, 9/02/2005, 7/28/2005, 7/08/2005, 5/04/2005, 1/03/2005, 10/19/2004, 12/29/2003, 11/21/2003, 10/14/2003, .

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I, claims 1-9, in the reply filed on 9/7/07 is acknowledged.
2. Claims 10-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/7/07.

Priority

3. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application Nos. 10/369,980, 60/148,130, 60/150,737, and 09/738,608, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Specifically, the applications cited above do not specifically disclose the claimed method wherein an ablation probe is inserted into the apex region in the pericardium, the probe then enters the transverse pericardial space,

a first reflection is formed, the probe enters the opening of the first reflection to form a second reflection, the probe enters through the opening of the second reflection to form a third reflection, the probe enters through the opening of the third reflection and into the oblique pericardial sinus to surround the left and right pulmonary veins.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaska (US 6,237,605 B1).

With regard to **claim 1**, Vaska discloses a surgical procedure performed on the heart of a patient to surround and isolate the pulmonary veins (see entire document). The procedure comprises forming an entry incision in a subxiphoid location and placing an ablation device through the incision (column 3, lines 8-22). The device is then

inserted through an incision formed in the pericardium and beyond the left superior pulmonary vein (column 9, lines 30-46). Next, the ablation probe contacts the pericardial reflection superior to the right superior pulmonary veins (column 9, lines 46-52).

However, Vaska does not specifically disclose the instantly claimed steps of forming an opening in the first, second, and third reflections to surround and isolate the left and right pulmonary veins. Since Vaska discloses a method to surround and isolate the pulmonary veins in a patient and teaches that is known by one of ordinary skill in the art to cut and form openings in the reflections (column 10, lines 9-18), it would have been obvious to one of ordinary skill at the time of the invention for Vaska to perform the steps instantly claimed. Therefore, Vaska would disclose a method of surrounding and isolating the left and right pulmonary veins by forming an incision in a subxiphoid location and forming openings in the claimed reflections.

With regard to **claim 2**, the ablation probe of Vaska is energized to ablate atrial tissue (column 5, line 27 through column 6, line 64).

With regard to **claim 3**, it is the examiner's position that forming an entry incision in a subxiphoid location would inherently comprise exposing the linea alba absent evidence to the contrary.

With regard to **claim 4**, it is the examiner's position that forming an incision in a subxiphoid location, a subcostal location, to surround and isolate the pulmonary veins would intrinsically comprise exposing the anterior rectus sheath, retracting the rectus

muscles, incising the posterior rectus sheath, and forming a tract through the incisions and the muscular diaphragm into the pleural cavity absent evidence to the contrary.

With regard to **claims 5-7**, it is the examiner's position that forming openings in the claimed reflections would intrinsically include grasping a portion of each reflection to form an aperture therein, absent evidence to the contrary.

With regard to **claim 8**, Vaska also discloses the use of an endoscope with the ablation device (column 7, lines 54-58).

With regard to **claim 9**, Figure 2E discloses wherein the ablating device forms a loop.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

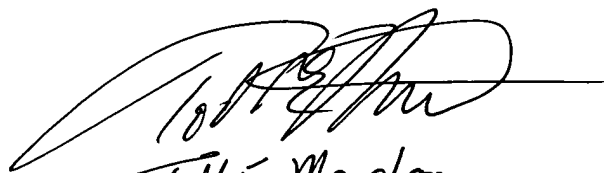
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/25/2007

ATL



Todd E. Manghon
SPE 3731